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| 10/523,053      | 02/02/2005  | Stanley George Bonney | P33090 USW          | 7571             |

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CORPORATE INTELLECTUAL PROPERTY, MAI B482

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RESEARCH TRIANGLE PARK, NC 27709-3398

EXAMINER

JACYNIA J CASIMER

ART UNIT

PAPER NUMBER

3754

NOTIFICATION DATE

DELIVERY MODE

06/17/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/523,053

**Applicant(s)**

BONNEY, STANLEY GEORGE

**Examiner**

J. Casimer Jacyna

**Art Unit**

3754

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5,7,8,10-16,18-29,32-34,36,38 and 45-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,7,8,10-16,18-29,32-34,36,38 and 45-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 033009
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 2, 5, 7, 8, 10, 11, 18-29, 32-34, 36, 38 and 45-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over German DE 100 17 438 in view of Clay 6,413,499. As noted in the PCT preliminary examination report dated 9/20/2004 DE/438 discloses a dispenser including a storage chamber 2, an outlet orifice 13, 35, a metering chamber 7, an outlet opening 18, a bleed arrangement 22 and a dispensing mechanism 3, 31 that functions as claimed as explained in the report. In regard to the functional language regarding three positions and two volumetric states, DE has the same claimed shape and is capable of being used in three different positions with two different volumes as claimed. Whether or not the dispenser of DE is used in this fashion depends on a future act of use and not on any claimed structural difference. In regard to the bleed arrangement, DE discloses a dispenser with the same claimed piston in a piston chamber with a side inlet wherein because the piston moves past the side inlet in the same manner as disclosed it must inherently perform the same function of bleeding material back into the storage chamber. Therefore, DE discloses a cream dispenser substantially as claimed but does not disclose the outlet to be a spray head sized for insertion into a nostril. However, Clay teaches another piston pump dispenser that also dispenses a gel which is of similar consistency to a cream having the gel or cream sprayed into a nostril and being sized and shaped for insertion into a nostril as disclosed on column 12, lines 32-44 and shown in figures 4B and 7 for the purpose of dispensing a gel or cream into a user's nasal cavities. Therefore, it would have been

obvious to one of ordinary skill in the art at the time the invention was made to provide the dispenser of DE/438 with a spray head sized for insertion into a nostril as, for example, taught by Clay in order to dispense a gel or cream into a user's nasal cavities.

3. Claims 1, 2, 5, 7, 8, 10, 11, 18-29, 32-34, 36, 38 and 45-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over German DE 100 17 438 in view of Alfonso et al. 6,017,963. The embodiment of figure 5 of DE/438 discloses a dispenser including a storage chamber 2, an outlet orifice nozzle 35 that will eject or spray the cream as claimed, a metering chamber 7, an outlet opening 18, a bleed arrangement 22 and a dispensing mechanism 3, 31 that functions as claimed as explained in the report. In regard to the functional language regarding three positions and two volumetric states, DE has the same claimed shape and is capable of being used in three different positions with two different volumes as claimed. Whether or not the dispenser of DE is used in this fashion depends on a future act of use and not on any claimed structural difference. In regard to the bleed arrangement, DE discloses a dispenser with the same claimed piston in a piston chamber with a side inlet wherein because the piston moves past the side inlet in the same manner as disclosed it must inherently perform the same function of bleeding material back into the storage chamber. Therefore, DE discloses a cream dispenser substantially as claimed but does not disclose the outlet nozzle 35 to be sized for insertion into a nostril. However, Alfonso teaches another pump dispenser on column 5, lines 11-14 that also dispenses a cream as disclosed on column 4, lines 49-51, that is used as a nasal cream for dispensing into the nostril. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made

to provide the dispenser of DE/438 with a nasal cream as, for example, taught by Alfonso in order to increase the versatility and usefulness of the dispenser and also to size the outlet nozzle 35 to fit into a nostril to enable the nasal cream to be dispensed into a user's nasal cavities.

4. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over German DE 100 17 438 in view of Alfonso et al. 6,017,963 as applied to claim 1 above and further in view of Davis 2,497,762. DE/438 discloses a piston pump dispenser including a storage chamber 2 and a metering chamber 7 substantially as claimed but does not disclose the dispenser to be capable of remaining closed when moved between the first and second states. However, Davis teaches another piston pump dispenser including a storage chamber 10 and a metering chamber 18 and further teaches that these types of dispensers can have a low volume position as in figure 3 or a high volume position as in figure 4 wherein the dispenser can be adjusted from the high volume to the low volume position without dispensing fluid as claimed for the purpose of using the dispenser to dispense two different volumes of fluid. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the dispenser of DE/438 with the ability to move between first and second volumetric states without opening the outlet as, for example, taught by Davis in order to attain the ability to dispense two different volumes of fluid.

5. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over German DE 100 17 438 in view of Clay 6,413,499 as applied to claim 1 above and further in view of Davis 2,497,762. DE/438 discloses a piston pump dispenser including

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a storage chamber 2 and a metering chamber 7 substantially as claimed but does not disclose the dispenser to be capable of remaining closed when moved between the first and second states. However, Davis teaches another piston pump dispenser including a storage chamber 10 and a metering chamber 18 and further teaches that these types of dispensers can have a low volume position as in figure 3 or a high volume position as in figure 4 wherein the dispenser can be adjusted from the high volume to the low volume position without dispensing fluid as claimed for the purpose of using the dispenser to dispense two different volumes of fluid. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the dispenser of DE/438 with the ability to move between first and second volumetric states without opening the outlet as, for example, taught by Davis in order to attain the ability to dispense two different volumes of fluid.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Applicant's arguments filed 3/30/2009 have been fully considered but they are not persuasive. Applicant is essentially contending the DE or Katz does not disclose a method of use and not a difference in structure. If one were to depress the piston of Katz a set distance one would dispense a repeatable and metered amount of fluid. The same amount of material will be dispensed for the same linear movement of the piston regardless of whether or not the piston and chamber shapes match exactly. The fact

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that the shapes do not match exactly does mean that some fluid will remain in the chamber when a dispense cycle is finished. However, dispensing the piston a set length will dispense a measured amount of material since the amount remaining in the chamber will be constant or the same for each depression of the piston. The location of conduit 22 defines that it will inherently function as a bleed conduit regardless of whether or not DE/Katz discloses this inherent function.

8. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Casimer Jacyna whose telephone number is 571-272-4889. The examiner can normally be reached on Mon. thru Fri. 9AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571-272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. Casimer Jacyna/  
Primary Examiner, Art Unit 3754